GP1723

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Daniel W. Armstrong

Docket No. AST-4A-PCT-US

Serial No. 08/851,485

Examiner: E.G. Therkorn

Filed: May 5, 1997

Group Art Unit: 1723

For: MACROCYCLIC ANTIBIOTICS AS SEPARATION AGENTS

600 Third Avenue
New York, New York 10016
August 5, 1998

Asst. Commissioner of Patents
Washington, D.C. 20231

SIR:

This is in response to an Office Action dated July 13, 1998 in the above-identified case. Please amend the application as follows:

ELECTION OF SPECIES

Election I

Separation: Conventional Supported Chromatography

Claims : 1, 5, 9, 15-22, 24-26

This election made with traverse.

Election II

Antibiotic: teichomycin (teicoplanin)

Claims : 1, 5, 6, 9, 10, 16, 18-20, 27-29

This election made with traverse.

In the Claims:

Claim 28, line 1, change "23" to --27--.

The following two elections of species are required:

ELECTION I

This application contains claims directed to the following patentably distinct species of the claimed invention: Each type of separation such as conventional supported chromatography, mobile phase additive chromatography, and electrophoresis are considered to be a distinct species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 7 is considered to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

ELECTION II

This application contains claims directed to the following patentably distinct species of the claimed invention: Each antibiotic such as rifamycin B, gramicidin 5, and amphotericin B is considered to be a distinct species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 7 is considered to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (703) 308-0362.

Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT/11
July 9, 1998